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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/692,916  | 10/24/2003  | Michael Roberts      | 00216-368005        | 9057             |
| 26161   | 7590        | 05/17/2005           | EXAMINER            |                  |
| FISH & RICHARDSON PC<br>225 FRANKLIN ST<br>BOSTON, MA 02110 |             |                      | SPISICH, MARK       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1744                |                  |
| DATE MAILED: 05/17/2005                                     |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/692,916

Applicant(s)

ROBERTS ET AL.

Examiner

Mark Spisich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 55 and 57-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 55 and 57-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 31 March 2005 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 55, 57 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 1-72128 (hereinafter '128) in view of Dolinsky (USP 4,288,883). '128 discloses an oral brush comprising a handle (3) with a head portion (1) at an end thereof and which head portion includes a brush portion including a plurality of non-elastomeric (nylon) bristles as well as a plurality of elastomeric bristles (page 5, line 28 thru page 6, line 4 of the attached translation). The preferred elastomer may be either a polyester based or polystyrene based thermoplastic elastomer (see page 4 of the attached translation) or block copolymers. With regard to the particular material (claim 55, lines

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9-10), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the elastomeric elements of the recited material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, especially given the fact that '128 discloses the broad class of materials recited in the claim(s). *In re Leshin*, 125 USPQ 416. With regard to the hardness, the device of '128 discloses as having the same utility (an oral brush) as that of the claimed device and it is not unreasonable to assume that one of ordinary skill would not deem it obvious to select materials with properties that would not harm the user's gums or teeth. With regard to the "radiused terminal end" (claim 55, line 7), the patent to Dolinsky discloses rubber massage members (22a) (column 1, lines 46-50) with rounded or radiused terminal ends (see fig 4 and column 2, lines 26-27). It would have been obvious to one of ordinary skill to have rounded the ends of the bristles (both elastomeric as well as conventional) of '128 to reduce any damage to the user's gums.

4. Claims 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 1-72128 and Dolinsky (USP 4,288,883) as applied to claim 55 above, and further in view of Muhler et al (USP 3,613,143). The prior art discloses the invention substantially as claimed with the exception of the non-elastomeric (nylon) bristles including an abrasive. The patent to Muhler discloses an oral brush including plastic (nylon; column 3, line 26) including a dental abrasive (column 3, line 15) and having a diameter of 8 mil (column 8, line 44). It would have been obvious to one of ordinary skill

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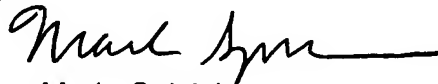
to have modified the non-elastomeric (nylon) bristles of '128 as such to more effectively clean and polish tooth surfaces.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (571) 272-1278. The examiner can normally be reached on M-Th (5:30-3:00), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Kim can be reached on (571) 272-1142. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark Spisich  
Primary Examiner  
Art Unit 1744

MS